

REMARKS/ARGUMENTS

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

Claims 1-36 are pending in the present application. Claims 2-4 were canceled. Claims 1,3, 7, 33, and 36 were amended. No claims were added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 101

The Examiner has rejected claims 1-32 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

Applicants have amended claim 1 to include the following elements:

gathering a plurality of capacity data for a capacity resource set, the capacity resource set including a central processing unit, a storage, a memory, a network or telecommunications hardware, a plurality of peripheral devices;

analyzing the capacity data by extracting capacity obligations from a database and comparing the capacity obligations with existing resources to identify capacity obligations that can be met with existing resources, and to identify capacity obligations that require additional resources.

Applicants submit that amended claim 1, at least because of the foregoing elements, overcomes the rejection under 35 U.S.C. § 101. Claims 2-32 depend from claim 1 and so each dependent claim also overcomes the rejection under 35 U.S.C. § 101.

II. 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 3 and 7-12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

The Examiner states:

The term "regular need" in claim 3 is a relative term which renders the claim indefinite. The term "regular need" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the sake of examination, Examiner interprets this term as "need."

Applicants have amended claim 3 to delete "regular".

Claim 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "standard data" and "non-standard data" recited in claim 7-12 do not have clear definition either in the specification or claim; and it is not clear regarding the scope of these terms. For the sake of interpretation, Examiner interprets the terms as "provided and "not provided", in light of specification PGPub paragraph [0035].

Office Action dated April 1, 2009, pages 4-5.

Applicants have amended claim 7 to change “standard” to --provided-- and to change “non-standard” to --not provided--.

Therefore, the rejection of claims 3 and 7-12 under 35 U.S.C. § 112, second paragraph has been overcome.

III. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 1-2, 5-10, 13, 16-18, 22-26 and 28-36 under 35 U.S.C. § 102 as being anticipated by Valdivia et al. (U.S. Patent No. 6,904,265), hereinafter “*Valdivia*”. This rejection is respectfully traversed.

Applicants have amended claim 1 to incorporate the limitations of claims 2 and 4. Therefore, the rejection under 35 U.S.C. § 102 has been overcome.

IV. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 3-4 under 35 U.S.C. § 103 as being unpatentable over *Valdivia* and further in view of Wickham et al. (U.S. Patent No. 6,307,546), hereinafter “*Wickham*”. This rejection is respectfully traversed.

“[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A rejection under 35 U.S.C. § 103(a) must be based on the following factual determinations: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of non-obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

“The combination of familiar elements according to known methods is likely to be obvious when

it does no more than yield predictable results.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007)). “[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 127 S. Ct. at 1740.

Discussing the obviousness of claimed combinations of elements of prior art, *KSR* explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida v. AG Pro, Inc.*, 425 U.S. 273 (1976) and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. If the claimed subject matter “involve[s] more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement,” *id.*, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *Id.* at 1740-41. “To facilitate review, this analysis should be made explicit.” *Id.* at 1741. That is, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

A. Amended Claim 1

Claim 1 has been amended to incorporate the limitations of claims 2 and 4. Claim 1 now recites:

A computer-implemented process for managing capacity resources in a shared computing environment comprising the steps of:

- gathering a plurality of capacity data for a capacity resource set, the capacity resource set including a central processing unit, a storage, a memory, a network or telecommunications hardware, a plurality of peripheral devices;
- analyzing the capacity data by extracting capacity obligations from a database and comparing the capacity obligations with existing resources to identify capacity obligations that can be met with existing resources, and to identify capacity obligations that require additional resources;
- generating the capacity plan for using the identified existing resources and the identified additional resources to meet capacity obligations;
- gaining approval for the capacity plan from one or more persons with the authority to commit to the implementation of the capacity plan;
- notifying any parties to the capacity plan of the plan details;
- handling capacity requests from a requester;
- performing analysis review on capacity requests to identify capacity issues;
- executing a problem manager program in a data-processing system to resolve any identified capacity issues so that a service provider can meet all service obligations;
- responsive to determining that the capacity data is not already available, contacting the capacity data owner;
- requesting the capacity data;
- justifying the request for the capacity data to the capacity data owner; and
- identifying a plurality of future capacity planning issues based on a selection of a set of projection methodologies including business drivers, linear regression, percent change, direct customer Input, and historical trend data.

Claim 1 now incorporates the limitations of claims 2 and 4. In regard to claim 4, the Examiner stated:

As to claim 4, Valdivia-Wickham discloses the process of claim 2 further comprising the steps of: responsive to determining that the capacity data is not already available, contacting the capacity data owner (Wickham, col. 10, lines 60-62); requesting the capacity data; and justifying the request for the capacity data to the capacity data owner (Wickham, col. 10, lines 51-57).

The cited portions of *Wickham* state the following:

The message asks for state information and includes a request for objects "contained by" the model object receiving the message. The model object checks

its own state to determine whether the requested objects have 55 already been retrieved (during the same network access session, the user might return to the network map display). If the model objects have already been retrieved from the network, the model object answers the "cached" objects. If the requested objects, corresponding to respective structural 60 components of the selected node or terminal, have not been retrieved, then the model object retrieves them, "installs" them into the domain model and answers them.

The cited portions of *Wickham* fail to explicitly disclose the limitation of former claim 4. Indeed, *Wickham* is silent as to the limitation of claim 4. While the limitation is not explicitly disclosed, it could be inherent. However, the limitation cannot be inherent because it cannot be shown that the limitation necessarily follows from the teaching of *Wickham*.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Since *Wickham* neither explicitly nor inherently teaches the limitations of claim 4, claim 1 which now recites those limitations is in condition for allowance.

B. Claim 3

Claim 3 recites:

The process of Claim 2 wherein gathering capacity data comprises the steps of:

- determining capacity data requirements;
- determining suppliers of the capacity data;
- determining if the capacity data is already available;
- acquiring the capacity data from the database;
- validating the capacity data;
- determining if there is a ~~regular~~ need for the data; and
- updating and documenting the database.

In regard to claim 3, the Examiner states:

As to claim 3, Valdivia discloses the process of claim 2 wherein gathering capacity data comprises the steps of: determining capacity data requirements (figure 4, "Wholesaler-NSP Agreements; NSPBBS Agreements"); determining suppliers of the capacity data (figure 4, NOC has separate interfaces ("IF") for Wholesaler, NSP, for example, therefore the supplier of the capacity data is determined by its corresponding interface). Valdivia does not expressly disclose determining if the capacity data is already available; acquiring the capacity data from the database; validating the capacity data; determining if there is a regular need for the data; and updating and documenting the database. Wickham discloses determining if the requested data is already available (col. 10, lines 52-56, "determine whether the requested objects have already been retrieved"); acquiring the requested data from the database (col. 10, lines 45-48, "the information is now retrieved from a network database"; lines 58-59, "answers the "cached" objects"); validating the requested data (col. 10, lines 53-55, "checks its own state and determines whether the requested objects have already been retrieved"); determining if there is a regular need for the data (See 112 rejection above and Examiner's interpretation for "regular need; col. 10, lines 58-62, the requested data is determined as needed data) and updating and documenting the database (col. 10, lines 58-62, "installs them into the domain model and answers them").

The cited portion of *Wickham* is as follows:

This information is now retrieved from a network database, in particular from the selected node or terminal. A clicking via mouse 74 on a node icon 92 or 94 results in a message being sent to a model 50 object in memory corresponding to the selected node or terminal. The message asks for state information and includes a request for objects "contained by" the model object receiving the message. The model object checks its own state to determine whether the requested objects have 55 already been retrieved (during the same network access

session, the user might return to the network map display). If the model objects have already been retrieved from the network, the model object answers the "cached" objects. If the requested objects, corresponding to respective structural 60 components of the selected node or terminal, have not been retrieved, then the model object retrieves them, "installs" them into the domain model and answers them.

Wickham, col. 10, lines 45-62.

The cited portions of *Wickham* fail to explicitly disclose the limitation of former claim 4. Indeed, *Wickham* is silent as to the limitation of claim 4. Therefore, *Wickham* cannot remedy the deficiency of *Valdivia*. Moreover, in addition to being silent as to the limitation, the limitation cannot be inherent because it cannot be shown that the limitation necessarily follows from the teaching of *Wickham*.

Furthermore, *Wickham* and *Valdivia* are not properly combined. In combining references, an explicit analysis is required to combine or modify references. The Supreme Court has stated the following:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int'l v. Teleflex Inc. 127 S. Ct. 1727, 1741 (2007). Conclusory statements are insufficient to support obviousness rejections. In particular, "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

The Examiner stated the following in combining the cited references

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the teachings disclosed by Valdivia, with the teachings disclosed by Wickham regarding determining if the requested data is already available; acquiring the requested data from the database; validating the requested data; determining if there is a regular need for the data; and updating and documenting the database. The suggestion and motivation of the combination would have been to improve efficiency (Wickham, col. 10, line 63, "lazy" retrieval).

As can be seen, an express analysis has not been provided in the Examiner's reasons for combining the references. The statements made by the Examiner do not provide reasons as required in the Supreme Court guidance on combining references in the KSR case. Instead, the Examiner has only provided statements that are conclusory or reciting some desired goal. These conclusions and desired goals have not been supported with any explicit analysis or articulated reasoning with some rationale underpinnings to support the conclusions or goals for combining the elements in these two references in the manner proposed by the Examiner. Further, even if these conclusory statements or goals could be considered "reasons", they do not have any articulated reasoning with some rational underpinning to support the Examiner's assertion of obviousness.

The Examiner has merely offered a goal or desire to improve efficiency. To meet this goal, the Examiner states it would have been obvious to combine Wickham and Valdivia. Nowhere, however, has the Examiner gone beyond this desired goal to explain sufficiently why one of ordinary skill in the art would have combined these two references.

The Examiner has rejected claims 11, 14-15 and 19-20 under 35 U.S.C. § 103 as being unpatentable over *Valdivia*, as applied to claim 1, and further in view of *Wichelman et al.* (U.S. Patent No. 6,853,932), hereinafter "*Wichelman*."

Claims 11, 14-15 and 19-20 depend from claim 1 which is now in condition for allowance. Therefore, claims 11, 14-15 and 19-20 are also in condition for allowance.

The Examiner has rejected claim 27 under 35 U.S.C. § 103 as being unpatentable over *Valdivia*, as applied to claim 1, and further in view of Official Notice, hereinafter "*ON*."

Claim 27 depends from claim 1 which is now in condition for allowance. Therefore, claim 27 is also in condition for allowance.

The Examiner has rejected claim 12 and 21 under 35 U.S.C. § 103 as being unpatentable over *Valdivia*, in view of *Wichelman*, as applied to claim 11, and further in view of Whitman, Jr. (U.S. Patent 7,499,844), hereinafter “*Whitman, Jr.*”.

Claims 12 and 21 depend from claim 1 which is now in condition for allowance. Therefore, claims 12 and 21 are also in condition for allowance.

V. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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